

**REMARKS**

This is in response to the Office Action mailed on February 10, 2004, in which claims 1-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson et al. (U.S. Pat. No. 5,077,607) in view of Takemura (JP 404372057A) and Kosuda et al. (JP 411339106A).

The Examiner cites Johnson et al. as the base reference that discloses a cable television system for providing automated checkout by a guest from a hotel. The system has a head end connected through a distribution system to a plurality of guest terminals located in the guest rooms of the lodging facility. Applicant agrees Johnson et al. does make the aforementioned disclosure, as the present application similarly made the disclosure in the background of the invention at page 1, line 11-page 3, line 4. The disclosure of Johnson et al. is known by those of skill in the art, however, the Johnson et al. lacks any indication of electronically sending a receipt.

The disclosure of Johnson et al. is parallel to the system described in the background of the invention. That is, the reference discloses a video checkout system, but it does not eliminate the personal handling of the account statement by the lodging facility staff. There is no suggestion to send a receipt electronically to a destination provided by the guest as part of video checkout. In Johnson et al., the receipt that is issued upon video checkout must either be picked up by the hotel guest, which creates a delay for the guest in the checkout process, or be mailed to an address given by the guest. The mailing of the receipt poses additional problems in that the hotel must be careful to assure that the proper statements are sent to the proper guests. Because manual handling is still required, there is potential that a guest will not receive a receipt or will be sent the wrong receipt. The current system alleviates this problem by assuring that the receipt will be addressed by the guest. The receipt is sent electronically to the destination of the guests choosing. There is no disclosure of this in the Johnson et al. reference.

Johnson et al. in fact teaches away from the present invention. Johnson et al. specifically mentions a printer for printing out checkout bills in either the room or at the hotel front desk. *See Col. 5, lines 36-39; Col. 7, lines 8-11.* Prior art must be considered in its entirety, including disclosures that teach away from the claims. MPEP § 2142.02 (citing *W.L. Gor & Assoc.*,

*Inc. v. Gorlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)). Obviousness cannot rest on art that in any material respect teaches away from the disclosed invention. *In Re Geisler*, 116 F.3d 1465 (Fed. Cir. 1997)). A reference teaches away when a person of ordinary skill in the art would, upon reading the reference be led in a direction divergent from the path taken by the applicant. *TecAir, Inc., v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360 (Fed. Cir. 1999). One of ordinary skill in the art would recognize that Johnson et al. is teaching a delivery of the receipt to a pre-existing printer for subsequent manual handling, and not electronically sending the receipt to a destination chosen by the guest as required by independent claims 1 and 6. Thus, Johnson et al. discloses and teaches toward the very problem that the present application tries to alleviate. As such, Johnson et al. does not render the claims presented obvious to one of ordinary skill in the art.

The lodging industry has long known of drawbacks associated with manual checkout. The lodging industry is also aware of a guests wants and needs, especially relating to comfort. Entertainment systems have long been known in the art and are put into rooms to appease guests. Soon thereafter, the idea of video checkout was introduced into the industry. This is evidenced by the Johnson et al. reference. Video checkout was to speed along the checkout process to make a guest's stay as simple and easy as possible. However, video checkout still requires substantial involvement of lodging facility staff. The receipt of charges for a stay at a facility needs to be picked up at a central location, such as the front desk, which requires the guest to spend additional time waiting. An alternative to this is to have the hotel staff mail a receipt, which requires waiting for the receipt. Also, mailing of the receipt requires personal handling of the receipt by the hotel staff.

Much time and research has been used in trying to improve lodging industry services over the last two decades, including improvements in amenities offered to guests via electronic means such as pay-per-view movies and television, video games, highspeed Internet connectivity, and on-line services including video shopping. Knowledge of these systems have been around for a number of years as evidenced by the Johnson et al. disclosure. However, until the present invention, no person has created a checkout system from a lodging facility that does not require interaction and involvement of lodging facility staff.

Takemura and Kosuda et al. teach the delivery of electronic receipts via either e-mail or facsimile. Both references are done in the context of an automatic teller machine. Knowledge of both facsimiles and email has been around for the past several years. However, there has been no disclosure towards the use of sending checkout receipts from lodging facilities by using electronic means so that checkout can be accomplished entirely without involvement of hotel staff members.

The Examiner cites to the Takemura and Kosuda et al. references for teaching of sending a receipt electronically to a user's destination. These references are dated December 25, 1992 for the Takemura and December 10, 1999 for the Kosuda et al. reference. The Johnson et al. reference is dated December 31, 1991. Thus, all references were known to the public at the time of the filing of the application.

Facsimile transmission has been known since the date of the Johnson et al. reference. Email has also been known since that time, although its prevalence and use by the general public may have come at that time or a few years later. In any case, electronic transmission has been known for years, as has video checkout. However, until the filing of this application, no one has suggested or had the idea to combine electronic transmission of receipt with video checkout in order to achieve checkout without manual steps performed by hotel staff. The Takemura and Kosuda et al. references relate specifically to bank transactions. One of skill in the art of the lodging industry would not be looking to bank transactions to help provide improvements to amenities for guests.

"Particular findings must be made as to the reason the skilled artisan, with no knowledge of claimed invention, would have selected these components for combination in the manner chosen." *In Re Kotzab* 217 F.3d 1365, 1371 (Fed. Cir. 2000). This is because most, if not all inventions, are combinations of old elements, which is why there is a requirement for a specific motivation to combine supported by the references. *Id.* The invention taught is not to be used against the applicant to combine references in hindsight to render the invention obvious. *In Re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). There is no motivation present in the references to combine Takemura and Kosuda et al. with the Johnson et al. reference. As previously stated, Johnson et al. actually teaches away from the current invention and thus is void of any motivation

to combine the reference with Takemura and Kosuda et al. Suggesting such a combination is in fact using the current application as a road map to find a combination. It is only in hindsight after looking at the application that one would combine the video check out with electronic transmitted receipt.

**CONCLUSION**

In view of the above comments, it is believed that claims 1-12 of the present application are in condition for allowance. Reconsideration and notice to that effect is respectfully requested. The Examiner is invited to contact the undersigned at the telephone number listed below if such a call would in any way facilitate allowance of the application.

Respectfully submitted,

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Date: 4/30/04

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